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Dr. Sergei V. Belyaev
Russia, 141700, Moscow region,
Dolgoprudny, prospect Patsaeva, d.14, kv.77

In re Application of LAZAREV et al
U.S. Application No.: 09/485,168
PCT Application No.: PCT/RU98/00250
Int. Filing Date: 03 August 1998
Priority Date: 04 August 1997
For: LIQUID CRYSTAL DISPLAY

Dear Dr. Belyaev:

You are named as a joint inventor in the above-captioned United States national stage application, filed under the provisions of 37 CFR 1.47(a) and 35 U.S.C. 116. Should a patent be granted, you will be designated as an inventor.

As a named inventor, you are entitled to inspect any paper in the file wrapper of the application, order copies of all or any part thereof (at a prepaid cost set forth in 37 CFR 1.19) or to make your position of record in the application. Alternatively, you may arrange to do any of the preceding through a registered patent agent or attorney presenting written authorization from you. If you choose to join in the application, counsel of record (see below) would presumably assist you. Joining in the application would entail the filing of an appropriate oath or declaration by you pursuant to 37 CFR 1.63.

Bryan Tung
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26 West 61st Street
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Attorney Docket No.: U 012593-1

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DECISION

This is in response to applicant's "Petition for Revival of an Application for Patent Abandoned Unintentionally Under 37 C.F.R. § 1.137(b)" and "Response to Decision on Renewed Petition Under 37 CFR 1.47(A)" filed 03 October 2002, requesting that the present application be accepted for national stage processing without the signature of joint inventor Sergei Vasilievich Belyaev.

BACKGROUND

On 03 August 1998, applicant filed international application PCT/RU98/00250, which claimed priority of an earlier Russian application filed 04 August 1997. A copy of the international application was communicated to the United States Patent and Trademark Office from the International Bureau on 11 February 1999. A Demand for international preliminary examination, in which the United States was elected, was filed on 26 February 1999, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 04 February 2000.

On 03 February 2000, applicant filed national stage papers in the United States Designated/Elected Office (DO/EO/US). The submission was accompanied by, inter alia, the requisite basic national fee as required by 35 U.S.C. 371(c)(1).

On 20 April 2000, the DO/EO/US mailed a "Notification of Missing Requirements Under 35 U.S.C. 371" (Form PCT/DO/EO/905), indicating that an oath or declaration in compliance with 37 CFR 1.497 must be filed along with a surcharge under 37 CFR 1.492(e) for providing the oath or declaration later than thirty (30) months from the priority date.

On 19 May 2000, applicant filed a petition under 37 CFR 1.47(a) accompanied by, *inter alia*, an original declaration signed by two of the three joint inventors, the \$65.00 small entity fee for furnishing a declaration later than thirty (30) months from the priority date, and the \$130.00 petition fee required by 37 CFR 1.17(i).

On 26 June 2000, applicant filed a declaration by applicant's attorney Vladimir Biriulin in support of the 19 May 2000 petition.

On 16 August 2000, this Office mailed a decision dismissing the 26 June 2000 petition on grounds that applicants had not provided an affidavit or declaration by the person having firsthand knowledge of a 06 March 2000 letter purportedly not responded to by the nonsigning inventor and that the petition did not identify the last known address of the nonsigning inventor.

On 23 October 2000, applicant filed a renewed petition under 37 CFR 1.47(a) along with a declaration by Carl Cobb, the person having firsthand knowledge of communications with the nonsigning inventor.

On 08 November 2000, applicant filed a supplement to the renewed petition.

On 15 March 2001, this Office mailed a decision dismissing the renewed petition on grounds that applicant had not adequately demonstrated that Belyaev refuses to sign the application papers.

On 10 September 2002, the DO/EO/US mailed a Notification of Abandonment (Form PCT/DO/EO/909).

On 03 October 2002, applicant filed the present petition under 37 CFR 1.137(b) and the present renewed petition under 37 CFR 1.47(a).

DISCUSSION

I. Petition Under 37 CFR 1.137(b)

Under 37 CFR 1.137(b), a petition requesting that an application be revived on the grounds of unintentional abandonment must be accompanied by: (1) the required reply unless previously filed, (2) the petition fee as set forth in 37 CFR 1.17(m), (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional, and (4) a terminal disclaimer if the application was filed before 08 June 1995.

With regard to item (1), applicant has provided the required reply.

With regard to item (2), applicant has provided the required petition fee.

With regard to item (3), applicant has provided the required statement.

With regard to item (4), because the international application was filed after 08 June 1995, no terminal disclaimer is required.

Therefore, all the requirements for a petition under 37 CFR 1.137(b) have been satisfied.

II. Petition Under 37 CFR 1.47(a)

A petition under 37 CFR 1.47(a) must be accompanied by: (1) an oath or declaration by each applicant on his or her own behalf and on behalf of the nonsigning joint inventor, (2) factual proof that the missing joint inventor refuses to join in the application or cannot be reached after diligent effort, (3) the fee set forth in 37 CFR §1.17(i), and (4) the last known address of the nonsigning joint inventor. See 37 CFR 1.47(a).

Applicant has previously satisfied items (1), (3), and (4) above.

With regard to item (2), MPEP 409.03(d) states in relevant part,

Where a refusal to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . .

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

In the present case, the declaration by Carl Cobb states that a copy of the application papers and a declaration form were sent to the nonsigning inventor Belyaev on 06 March 2000 (see paragraph 3 of Cobb's declaration). The copy of the 06 March 2000 letter (see "Exhibit 2" of the 26 June 2000 communication) shows a receipt acknowledgment with Belyaev's signature which appears to match that found on the Patent Right Assignment Contract (see "Exhibit 3" of the 26 June 2000 communication). Thus, applicant has demonstrated with reasonable certainty

that a bona fide attempt was made to present a copy of the application papers to Belyaev for signature.

The declaration by Cobb further states that a letter was mailed to Belyaev on 19 June 2000, requesting that Belyaev sign the application papers (see paragraph 9 of Cobb's declaration and "Exhibit 7" of the 08 November 2000 communication). Delivery of the letter to Belyaev is confirmed by a copy of the delivery confirmation receipts (see paragraph 9 of Cobb's declaration, "Exhibit 7" of the 23 October 2000 communication, and the associated English language translation filed with the present renewed petition). Belyaev's non-response to the 19 June 2000 letter evidences his refusal to sign. Thus, it can be concluded with reasonable certainty that Belyaev refuses to join in the application.

CONCLUSION

For the reasons in §I above, the petition under 37 CFR 1.137(b) is GRANTED.

For the reasons in §II above, the renewed petition under 37 CFR 1.47(a) is GRANTED.

This application has an international filing date of 03 August 1998 and a date under 35 U.S.C. 371(c) of 19 May 2000.

As set forth in 37 CFR 1.47(a), a notice of the filing of this application will be forwarded to the nonsigning inventor at the last known address of record and will be published in the *Official Gazette*.

This application is being forwarded to the United States Designated/Elected Office (DO/EO/US) for further processing in accordance with this decision.



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